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09/923,936	08/07/2001	Eric Romanski	2126-179	5169
20999	7590	06/23/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			WRIGHT, ANDREW D	
			ART UNIT	PAPER NUMBER
			3617	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/923,936
Filing Date: August 07, 2001
Appellant(s): ROMANSKI ET AL.

Ronald R. Santucci
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/7/05.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments*

The appellant's statement of the status of amendments contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal in the brief is correct.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

US 2,997,973	Hawthorne et al.	8-1961
US 4,897,303	McCullough, Jr. et al.	1-1990

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 5/28/04.

(11) Response to Argument

Applicant first argues that the cited references do not teach the claimed invention (Appeal Brief of 4/7/05, page 5). In response it is asserted that the references do teach or suggest all of the claim limitations. Specifically regarding claim 1, Hawthorne (US Pat. 2,997,973, hereinafter referred to as "Hawthorne") teaches all of the elements except for the means for rendering the tubular structure buoyant comprising thermoset or thermoplastic coating that renders the fabric buoyant. McCullough (US Pat. 4,897,303, hereinafter referred to as "McCullough") teaches a thermoset or thermoplastic coating that renders a fabric buoyant. Thus the references, when combined, teach or suggest all of the elements of the claims and applicant's argument is not persuasive.

Applicant second argues that there is no motivation to combine the cited references (Appeal Brief of 4/7/05, pages 5-6). In response it is noted that "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457- 58 (Fed. Cir. 1998). See also MPEP §2143.01. In this case the motivation asserted in the

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rejection is found in the knowledge of persons of ordinary skill in the art: namely that people who work with floating vessels don't want those vessels to sink. Thus a motivation has been provided, and applicant's argument that there is *no* motivation is not persuasive.

Further to the second argument, applicant argues that Hawthorne teaches away from the asserted combination used in the rejection. In response it is noted that Hawthorne makes no explicit teaching away from the use of additional buoyancy. There is no statement in Hawthorne that says buoyancy cannot or should not be added. Furthermore, Hawthorne makes no implied teaching away from the use of additional buoyancy. There is no description or suggestion that additional buoyancy might be detrimental to the apparatus. Applicant's single contrived situation where additional buoyancy might be disadvantageous does not support the assertion that Hawthorne teaches away from the subject.

Applicant third argues that hindsight is impermissible (Appeal Brief of 4/7/05, pages 6-7). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the motivation to combine is found in the knowledge that is generally available to the skilled artisan. Hawthorne teaches that the buoyancy of the vessel is provided by the liquid contents of the vessel (column 1, lines 30-32).

Hawthorne also teaches that the vessel is intended for transporting and storing cargo.

Filling and emptying are inherent parts of transporting and storing cargo, and

Hawthorne accordingly provides pipes for the express purpose of filling and emptying the cargo from the vessel. Since the only disclosed buoyancy comes from the internal

cargo, it follows that the vessel is not buoyant when there is little or no cargo held

within. Thus during routine operation of emptying the vessel, the vessel is at a risk of

sinking. The owner or operator of the vessel would be motivated by at least economic

and environmental reasons to prevent the vessel from sinking. Hawthorne teaches that

the fabric vessel is constructed and then is coated (i.e. "proofed") to provide water

impermeability (column 1, lines 65-72). McCullough teaches that the fabric of floatation

equipment may be coated to provide water-repellency (i.e. "hydrophobic") and buoyancy

(column 1, lines 5-13). The McCullough coating is similar to what Hawthorne already

discloses – a water-repellant or waterproof coating for fabric – and provides an

additional feature that potentially solves a problem with the Hawthorne apparatus. Thus

the skilled artisan wishing to make and use the Hawthorne apparatus, with both the

Hawthorne and McCullough patents in hand, would be motivated to add the McCullough

coating to the Hawthorne apparatus for the purpose of enhancing buoyancy to prevent

unwanted sinking of the vessel. This explanation takes into account only knowledge

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which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from the applicant's disclosure. Thus it is not hindsight reconstruction and applicant's argument is not persuasive.

Applicant fourth argues that obvious to try is not the standard for obviousness (Appeal Brief of 4/7/05, page 7). Applicant specifically argues that the "obvious to try" rationale is the only standard that lends viability to the 103 rejection. In response it is asserted that the combination of Hawthorne and McCullough is not based on an "obvious to try" rationale. The combination is based upon the recognition that the Hawthorne apparatus may sink when it is low or empty of cargo; that the sinking of floating vessels is generally undesirable; therefore, it would have been obvious to do something to prevent the sinking. The obvious to try rationale, on the other hand, generally deals with varying parameters or exploring new technology. Applicant's argument is misplaced and is not persuasive.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Andrew Wright
Examiner
Art Unit 3617

AW 6/16/05

**ANDREW D. WRIGHT
PRIMARY EXAMINER**

June 16, 2005

Conferees

S.M. *[Signature]*

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